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AMENDMENT AND RESPONSE
Ser No. 10/615,685

AUG 25 2006

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REMARKS

Upon entry of the present amendment, claims 1-2 and 4-10 will stand pending in the instant application. No new matter is added by the present amendment.

Support for Amendments to the Title and Claims

The amendment to the title of the instant application seeks to more clearly recite the subject matter of the instant claims and, thus, the instant invention.

The amendments to instant claims 1 and 7 seeks merely to incorporate the subject matter of instant claim 3 into the independent claims 1 and 7 so as to more clearly define the instant invention and to align the subject matter of the instant composition claims 1-6 with the instant method claims 7-10 for rejoinder. Support for the instant amendment may be found, for example, in the instant specification at page 3, lines 15-18.

The amendments in each of instant claims 1, 6 and 7 seek to avoid any possible indefiniteness issue with respect to the instantly recited amount of asymmetrically substituted aromatic polycarboxylic acid or any derivatives thereof. Please be advised that the term "phr" in the semi-crystalline polyester, as is instantly recited, is understood to mean parts per hundred parts polycarboxylic acid in a polyester resin. See, for example, the instant specification at page 7, lines 19-27; see also the Examples of semicrystalline polyster resins A, B and C: In Table 2 (Resin A), page 14, line 6, columns 1 and 2, in which the asymmetric substituted polyacid IPA represents $0.25/(0.25+1.0)$ or .20 or 20 parts per hundred parts of the aromatic polycarboxylic acid used to make a semi-crystalline polyester resin; in Table 3 (Resin B), page 15, line 4, columns 1 and 2, in which the asymmetric substituted polyacid TMA represents $0.43/(0.43+1.0)$ or .30 or 30 parts per hundred parts of the aromatic polycarboxylic acid used to make a semi-crystalline polyester resin; and, in Table 3 (Resin C), page 15, line 4, columns 1 and 2, in which the asymmetric substituted polyacid TMA represents $0.2/(0.2+1.0)$ or .166 or 16.6 parts per hundred parts of the aromatic polycarboxylic acid used to make a semi-crystalline polyester resin.

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Response to the Restriction Requirement and Request for Rejoinder

Please be advised that the Office Action incorrectly states on page 2, 2nd paragraph, that Applicants have elected claim 7-10 for prosecution. Applicants elected Group I, claims 1-6, with traverse.

Page 2 of the Office Action dated June 01, 2006 the restriction requirement inexplicably ignores the fact that a search of the method of using the coating powder (Group II, claims 7-10) and of the composition (Group I, claims 1-6) would not put an undue burden on the Examiner, adding only a single subclass of art in Class 427, subclass 195. See *Manual of Patent Classification*. The Office Action improperly alleges that because the claims of Group I and of Group II are distinct, the Office has met its burden.

However, distinctness does not address the question of search burden and the restriction requirement thus remains improper. It is well settled that the Office has the burden of showing that a search of the entire invention without restriction would place an undue burden on the Examiner. See MPEP 803. In addition, the Office must address all grounds of traversal set forth by Applicants.

Because the instant composition of Group I, claims 1-2 and 4-6, are allowable as written and because the method of using the composition of Group II, claims 7-10, incorporate all of the features of claim 1 therein, Applicants request rejoinder of all of the claims of Groups I and II. It is well settled that a composition and a method of using the same composition. See In re Ochiai, 37 USPQ2d 1127 (Fed Cir. 1995). Accordingly, Office practice dictates that rejoinder of Groups I and II is proper in this case. See MPEP 8.21.04, 1st and 2nd paragraphs.

Claim Rejections Under 35 USC §102(b)

Claims 1 and 4 stand rejected under 35 USC section 102(b) as being anticipated by O'Keefe et al. (O'Keefe), of record. The Applicants respectfully traverse this rejection.

As the rejection admits, O'Keefe fails to disclose a semi-crystalline polyester resin formed from a polyol and a polycarboxylic acid such that the polycarboxylic

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acid comprises 10 to 50 phr of the total weight of total polycarboxylic acid used to form the said semi-crystalline polyester is an asymmetrically substituted aromatic polyacid, ester, acid halide, anhydride, or a mixture thereof, as is instantly recited.

Because O'Keefe does not recite each and every element of the instant claims it cannot anticipate the instant claims. The rejections are improper and Applicants respectfully request their withdrawal.

Rejections Under 35 USC §103(a)

Claim 3 stands rejected under 35 USC §103(a) as being obvious over O'Keefe, of record, in view of Decker et al. (Decker), of record; further, claim 6 stands rejected under 35 USC §103(a) as being obvious over O'Keefe, of record, in view of Decker and further in view of Daly. The Applicants respectfully traverse these rejections.

Claim 3 has been incorporated into instant claim 1 and this discussion will address the subject matter of amended claim 1.

The rejection admits that O'Keefe fails to disclose a semi-crystalline polyester resin formed from a polyol and a polycarboxylic acid such that the polycarboxylic acid comprises 10 to 50 phr of the total weight of total polycarboxylic acid used to form the said semi-crystalline polyester is an asymmetrically substituted aromatic polyacid, ester, acid halide, anhydride, or a mixture thereof, as is instantly recited in claim 1.

The art Decker may not properly be combined with O'Keefe because there is no motivation in Decker to stop at an intermediate of Decker and combine that intermediate with O'Keefe. *In re Lalu*, 747 F.2d 703 (Fed. Cir. 1984). Any semi-crystalline polyester in Decker is adducted to a curing agent (to make adduct (B)) and nothing therein suggests the desirability of stopping the formation of the adduct of Decker in a final composition. See Decker at Abstract, lines 7-15, col. 1, line 64 to col. 2, line 9, and col. 3, lines 47-53.

Because the combination of O'Keefe and Decker is improper it cannot render the instant claims obvious.

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Daly fails to make up for any of the deficiencies of either Decker or O'Keefe because Daly fails to disclose the instantly recited semi-crystalline polyesters from an asymmetrically substituted aromatic polyacid, ester, acid halide, anhydride, or mixture thereof. Further, the combination of O'Keefe and Decker is improper, as discussed above, and does not supply the instant claim features missing in Daly. The rejections are improper and Applicants respectfully request their withdrawal.

Claim 2 stands rejected under 35 USC §103(a) as being obvious over O'Keefe, of record, in view of Pietila et al. (Ahjopalo), of record. The Applicants respectfully traverse this rejection.

In addition to its shortcomings mentioned in regard to anticipation, above, the rejection admits that O'Keefe fails to disclose non-blooming polyesters, instantly recited in claim 2.

The art of Ahjopalo is an academic survey that fails to actually disclose or suggest a non-blooming polyester. In fact, Ahjopalo fails to establish that any specific polyol or reactant combination leads to a non-blooming polyester. See, for example, "Conclusions" at page 8290, left hand column (cyclization is observed in several, if not all species of 2-butyl-2-ethyl-1,3-propanediol (BEPD) polyesters shown in the model) and at page 8286, left hand col. and in Table 2 (IPA-containing polymers form cyclic trimers and all polyesters shown in the Table form cyclic dimers). While the law requires some reasonable expectation of success in a combination made to show a claimed thing as obvious, no such expectation results from the instantly alleged combination of O'Keefe and Ahjopalo. See MPEP 2143.02. Accordingly, all polyesters in Ahjopalo would be expected to cause blooming in coatings and one would not have expected to make non-blooming polyesters in view of Ahjopalo.

Because the combination of O'Keefe and Ahjopalo is not expected to succeed in the alleged combination, it cannot render the instant claims obvious. The rejections are improper and Applicants respectfully request their withdrawal.

Claim 5 stands rejected under 35 USC §103(a) as being obvious over O'Keefe, of record, in view of Daly, of record. The Applicants respectfully

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traverse this rejection. As stated above, Daly fails to make up for the deficiencies of O'Keefe regarding the instantly recited asymmetrically substituted aromatic polyacid, ester, acid halide, anhydride, or a mixture thereof.

Because the combination of O'Keefe and Daly does not recite each and every element of the instant claims it cannot render the instant claims obvious. The rejections are improper and Applicants respectfully request their withdrawal.

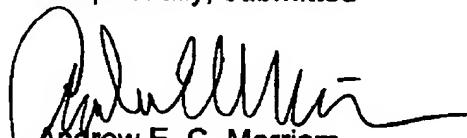
For these reasons, the rejections are clearly improper and should be withdrawn.

CONCLUSION

Based on the foregoing, the instant claims are believed to be in current condition for allowance. An early and favorable response is earnestly solicited. If the examiner has any questions problems concerning the instant application, she is urged to contact the undersigned at the number given below.

No fees are believed due. In the event that any fees are found owing, please charge deposit account no. 18-1850.

Respectfully, submitted



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